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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,093	01/17/2002	Hiroshi Kayakiri	217318US0DIV	7879

22850 7590 07/14/2003

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EXAMINER

DENTZ, BERNARD I

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 07/14/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Offic Action Summary

Application No.

10/047,093

Applicant(s)

KAYAKIRI ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 24 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 11-20 is/are rejected.
- 7) Claim(s) 1-7 and 10-14 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  - 1) Certified copies of the priority documents have been received.
  - 2) Certified copies of the priority documents have been received in Application No. 09/446,110.
  - 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) Notice of References Cited (PTO-892) *x1 reference*.
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

Each of the Gps. Is huge. The sulfur containing heterocycles are patentable over the oxygen containing. The restriction requirement is made final.

Group III is made up of claims 1-7 and 10-20. Claim 9 was erroneously included in paper no. 7.

Claims 1-7 and 11-20 are objected to for misjoinder of invention.

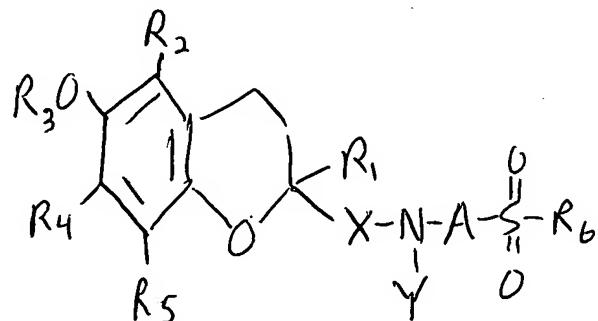
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

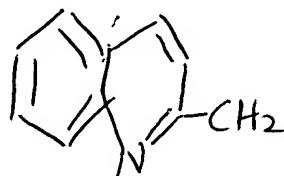
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Muller et al, US patent 5,889,045. It discloses compounds of the formula



Where R<sub>1</sub> is linear or branched alkyl, R<sub>2</sub>, R<sub>4</sub> and R<sub>5</sub> are identical or different and are H or alkyl, R<sub>3</sub> is H or alkyl, etc. or pertinently



R<sub>6</sub> can be alkyl, aryl etc.

X is carbonyl or methylene, A is a single bond. When the above given or highlighted values occur together a small genus of compounds overlapping the instant genus of claim 1 occurs. Note that many compounds taught by the reference anticipate the instant claims. Note that chromanyl is another name for the bicyclic moiety termed 3, 4-dihydro-2H-1-benzopyran in the reference. Note that the art utility is in the treatment of diabetes which is the instant activity.

Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Powell, US patent 4,606,753 cited by applicants. This reference discloses useful as herbicides or plant growth regulators bridged oxabicyclo containing compounds which are substituted by arylmethoxy or heterocyclmethoxy at one position <sup>and</sup> by a <sup>n</sup> alkyl or (aryl) sulfonylamino-carbonyl group at another position. See col.1 and ~~Embodiment~~ 20 at col.16 where the synthesis of a species is disclosed.

Besides avoiding the references applicants' new generic claim should recite ~~the~~ A as "optionally substituted heteropolycyclic group containing oxygen as the hetero atom or atoms and no other hetero atom".

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 308-4544. The examiner can normally be reached on Monday-Friday 8 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Rotman can be reached on 308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3592 for regular communications and 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Dentz/tgd  
July 11, 2003



BERNARD DENTZ  
PRIMARY EXAMINER  
GROUP 1650